

Appln. No. 10/033,927

Amendment dated February 4, 2004

Response to Office Action of January 5, 2004

PATENT

Attorney Docket No. **FORS-06675**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: J. Hall *et al.*

Serial No.: 10/033,297

Filed: 11/02/01

Entitled: **Invasion Assays**

Group No.: 1634


Examiner: Frank Wei Min Lu

**RESPONSE TO OFFICE ACTION
MAILED JANUARY 5, 2004**

Assistant Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

| | |
|---|---|
| CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A) | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 4, 2004 | |
| Dated: <u>February 4, 2004</u> | By:  Mary Ellen Waite |

Sir:

This communication is responsive to the Office Action mailed January 5, 2004, due on or before February 5, 2004.

REMARKS

Claims 1-34 were in the Application as filed. In a Preliminary Amendment filed with the application on November 2, 2001, Claims 1-34 were canceled and Claims 35-61 were added.

1. Previous Restriction and Species Election

The claims were previously restricted into two groups, with Group I comprising Claims 35-51 and Group II comprising Claims 52-61. Applicants elected Group I, and Group II Claims 52-61 were canceled without prejudice. Within elected Group I, the Examiner asserted that there are several patentably distinct species. Applicants elected Species (1) and Species (6). Applicants note with appreciation that the Examiner has withdrawn the Species election requirement for Species (3) and (4), and has combined Claims 40 and 41 together.



1634

PATENT

Attorney Docket No. FORS-06675

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jeff G. Hall *et al.*

Serial No.: 10/033,297

Group No: 1634

Filed: 11/02/2001

Examiner: Frank Wei Min Lu

Entitled: Detection Of Nucleic Acids By Multiple Sequential Invasive Cleavages

AMENDMENT TRANSMITTAL

Mail Stop No Fee

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)(1)(i)(A)

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is, on the date shown below, being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop No Fee, Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450

Dated: February 4, 2004

By: 

Mary Ellen Wate

Sir or Madam:

Transmitted herewith is an amendment for this application. The fee has been calculated as shown below.

| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NUMBER PREVIOUSLY PAID FOR | PRESENT EXTRA | | RATE | ADDITIONAL FEE |
|-----------------------|-------------------------------------|---|---------------------------------------|------------------|---|-------|-------------------|
| Total Claims | 17 | — | 20 | 0 | × | 18.00 | \$0.00 |
| Independent Claims | 1 | — | 3 | 0 | × | 86.00 | \$0.00 |

TOTAL DUE 0.00

1. No additional fee is required.
2. Please charge any additional fees, including any fees necessary for extensions of time, or credit overpayment to Deposit Account No. 08-1290. An originally executed duplicate of this transmittal is enclosed for this purpose.

Dated: February 4, 2004

By: Mary Ann Brow
Registration No. 42,363MEDLEN & CARROLL, LLP
101 Howard Street, Suite 350
San Francisco, California 94105
(608) 218-6900